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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,669	08/02/2001	Charles C. Freeny JR.	2551.062	6710

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EXAMINER

COURTENAY III, ST JOHN

ART UNIT

PAPER NUMBER

2126

DATE MAILED: 07/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,669

Applicant(s)

Charles C. Freeny JR.

Examiner

St. John Courtenay III

Art Unit

2126



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 2, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8-2-2001 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 6) ☐ Other:

ST. JOHN COURTENAY III
PRIMARY EXAMINER

Detailed Action

Disclosure Objected To, Embedded Hyperlinks or Other Forms of Browser-Executable Code

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink(s) and/or other form of browser-executable code. See MPEP § 608.01.

The requirement to delete an embedded hyperlink or other form of browser-executable code does not apply to electronic documents listed on forms PTO-892 and PTO-1449 where the electronic document is identified by reference to a URL.

The application contains disclosure entirely outside the bounds of the single claim. Applicant is required to modify the brief summary of the invention and restrict the descriptive matter so as to be in harmony with the claims (See MPEP § 1302.01).

The instant application elements fail to comply with 37 CFR §1.77:

Applicant has presented “Exhibit A”, “Exhibit B”, “Exhibit C”, and “Exhibit D” - each “Exhibit” is a separate self-contained patent application with its own background, detailed description, drawings, and page numbers that begin with page 1. The page numbering of the instant application is therefore not consecutive and fails to comply with 37 CFR 1.52(b)(5):

37 CFR 1.52(b)(5) Other than in a reissue application or reexamination proceeding, the pages of the specification including claims and abstract must be numbered consecutively, starting with 1, the numbers being centrally located above or preferably, below, the text.

The four disclosed "Exhibits" appear to be directed to separate inventions. The instant application contains extraneous subject matter that appears to be well outside the metes and bounds of the single claim.

Applicant is required to review and delete all such extraneous subject matter (i.e., all subject matter outside the bounds of the claims) and also to provide a substitute specification in full compliance with 37 C.F.R. §1.125, including a clean copy and a marked up version of the substitute specification showing all changes made [see §1.125(2)] and a statement that the substitute specification includes no new matter [see §1.125 (1)].

The deletion of such extraneous subject matter from the specification does not constitute any surrender of subject matter, as the originally-filed specification remains of record in the file.

All figures must be referenced in a SINGLE brief description of the drawings section.

The patent examiner has authority to require removal of any extraneous subject matter included within the specification that is entirely outside the bounds of the claims accepted by applicant so that the descriptive matter is in "harmony with the claims." See 37 CFR 1.71(c) and MPEP 1302.01.

Appropriate correction is required.

Obviousness-type double patenting Rejection:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

"Double patenting rejection of application claims was fully justified where applicant, in course of expanding first application to disclose enough more by way of details, alternatives, and additional uses to support broad, dominating, generic claims in later applications, has disclosed no additional invention or discovery other than that what was already claimed in patent on first application; there is significant difference between justifying broadening of claims and disclosing additional inventions." In re Van Ornum, 214 USPQ 761 (CCPA 1982).

Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1–17 of co-pending application 09/014,859, now U.S. Patent 6,243,743 (Freeny).

Although the conflicting claims are not identical, they are not patentably distinct from each other because of corresponding language that recites virtually all of the same elements and functions claimed in the previously patented invention; e.g., instant claim 1 differs only from claim 1 of U.S. Patent 6,243,743 with respect to the text shown in bold and underlined below:

"A split personal computer system for selectively processing video portions, input/output portions, computational portions and storage portions of personal computer tasks, comprising:

- a remote portion adapted to selectively perform the computational portions and the storage portions of the personal computer tasks, **the remote portion having a master operating software system stored thereon;**
- a local portion adapted to selectively perform the video portions and the input/output portions of the personal computer tasks, the local portion comprising:
 - a display unit located remotely from the remote portion of the split personal computer system;
 - an accessory unit in communication with the display unit;

- an input unit in communication with the accessory unit to input data signals into the accessory unit;
- communication means for interfacing the accessory unit with the remote portion of the split personal computer system for permitting data signals received by the accessory unit from the input unit to be transmittable from the accessory unit to the remote portion of the split personal computer system, the data signals being processable by the remote portion of the split personal computer system to generate output signals, the output signals including video signals and being transmittable from the remote portion of the split personal computer system to the accessory unit, and transmittable from the accessory unit to the display unit."

The instant claimed additional limitation, i.e., "the remote portion having a master operating software system stored thereon" is inherent as an operating system is a necessary component of a personal computer system and would therefore be obvious to a programmer of ordinary skill; the instant claim is merely a minor obvious variation of the base claims recited in the co-pending case.

Terminal Disclaimer

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

For post GATT applications, (i.e., applications filed after June 8, 1995), the rule § 1.321 (4) (c) (3) requires a provision that must be included. The following requirement is UNCHANGED by GATT and therefore a terminal disclaimer is required for the instant application, i.e., "shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection."

§ 1.321 Statutory disclaimers, including terminal disclaimers.

(a) A patentee owning the whole or any sectional interest in a patent may disclaim any complete claim or claims in a patent. In like manner any patentee may disclaim or

dedicate to the public the entire term, or any terminal part of the term, of the patent granted. Such disclaimer is binding upon the grantee and its successors or assigns. A notice of the disclaimer is published in the Official Gazette and attached to the printed copies of the specification. The disclaimer, to be recorded in the Patent and Trademark Office, must:

- (1) Be signed by the patentee, or an attorney or agent of record;
- (2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;
- (3) State the present extent of patentee's ownership interest in the patent; and
- (4) Be accompanied by the fee set forth in § 1.20(d).

(b) An applicant or assignee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted. Such terminal disclaimer is binding upon the grantee and its successors or assigns. The terminal disclaimer, to be recorded in the Patent and Trademark Office, must:

- (1) Be signed:
 - (i) By the applicant, or
 - (ii) If there is an assignee of record of an undivided part interest, by the applicant and such assignee, or
 - (iii) If there is an assignee of record of the entire interest, by such assignee, or
 - (iv) By an attorney or agent of record;
- (2) Specify the portion of the term of the patent being disclaimed;
- (3) State the present extent of applicant's or assignee's ownership interest in the patent to be granted; and
- (4) Be accompanied by the fee set forth in § 1.20(d).

(c) A terminal disclaimer, when filed to obviate a judicially created double patenting rejection in a patent application or in a reexamination proceeding, must:

- (1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;
- (2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent

application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and

(3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding **shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection.**

[47 FR 41281, Sept. 17, 1982, effective Oct. 1, 1982; revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; para. (c) revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996]

NOTICE OF RULE CHANGE

Effective July 30, 2003, all papers filed in the Office on or after that date will be subject to the rules changes found in the Federal Register/Vol 68, No. 125/ Monday, June 30, 2003. Certain rules changes affect patent applications filed before that date, see the Final Rule for further information. This notice can be viewed on the USPTO web site:

<http://www.uspto.gov/web/offices/com/sol/notices/68fr38611.pdf>

How to Contact the Examiner:

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to **St. John Courtenay III** whose voice telephone number is **(703) 308-5217**. A voice mail service is also available at this number.

Normal Flex work schedule: M – F 7:30 AM - 4:00 PM

- **All responses sent by U.S. Mail should be mailed to:**
PLEASE NOTE NEW USPTO MAILING ADDRESS EFFECTIVE MAY 1, 2003

**Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450**

- Hand-delivered responses should be brought to Crystal Park Two, 2021 Crystal Drive, Arlington, VA., Fourth Floor (Receptionist). All hand-delivered responses will be handled and entered by the docketing personnel. Please do not hand deliver responses directly to the Examiner.

Patent Customers advised to FAX communications to the USPTO

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/faxnotice.pdf>

PTO FAX NUMBERS:

- **AFTER-FINAL OFFICIAL faxes must be signed and sent to: (703) 746-7238.**
- **BEFORE-FINAL OFFICIAL faxes must be signed and sent to: (703) 746-7239.**


All OFFICIAL faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday, Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. See M.P.E.P. §505. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the Office, e.g., Finance Division for fee charging, etc.

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- Any inquiry of a general nature or relating to the status of this application should be directed to the **TC 2100 Group receptionist: (703) 305-3900.**

Please direct inquiries regarding fees, paper matching, and other issues not involving the Examiner to:

Technical Center 2100 CUSTOMER SERVICE: 703 306-5631

The Manual of Patent Examining Procedure (MPEP) is available online at:
<http://www.uspto.gov/web/offices/pac/mpep/index.html>


ST. JOHN COURTENAY III
PRIMARY EXAMINER
Paper #6 First Office Action